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Eric B Meyertons
Conley Rose & Taton PC
PO Box 398
Austin, TX 78767-0398

EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,307

Applicant(s)

CHILDRRESS ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16 and 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/03 has been entered.

Notice to Applicant

2. This communication is in response to the RCE filed 10/24/03. Claims 60, 61, 75, 78-79 and 80 have been amended. Claims 60-115 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 60-77, 80-93, 99, 101-105, and 107-115 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of :

- (1) whether the invention is within the technology arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

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For a claimed invention to be statutory, the claimed invention must be within the technological arts. More ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve use, or advance the technological arts to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Looking at claims 60-115 as a whole, nothing in the body of the claims recites any structure or functionality to suggest that a computer performs the recited steps.

Examiner notes that the common usage of terms such as "a computer readable-medium" or a "computer system" are well taken to be within the statutory categories within 35 U.S.C. 101 and therefore recommends using such terminologies.

As such, the above deficiencies may be cured by simply explicitly reciting that the claimed method /process steps are embodied or implemented on a "computer system" or on a "computer readable-medium" (as appropriate), provided Applicant show proper support for such recitations in the originally filed specification.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 60-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al (5,950,169) in view of Abbruzzese et al (5,557,515).

(A) As per claim 60, Borghesi discloses a method for processing an insurance claim to estimate a value of the insurance claim (Col.1, lines 24-55), the method comprising:

displaying a first insurance claim processing step on a display device coupled to a computer (Col.2, lines 60-67 to Col.3, line 30);

receiving input regarding the first insurance claim processing step (Col.2, lines 60-67 to Col.3, line 30);

determining a table of contents based at least on input received regarding the first insurance claim processing step (Col.7, lines 24-67 to Col.8, line 49);

determining a table of contents based at least on input received regarding the first insurance claim processing step (Col.7, lines 24-67 to Col.8, line 49);

displaying a table of contents on the display device, wherein the table of contents comprises a list of the steps associated with the processing of the insurance claim, and wherein the list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps (Col.8, lines 30-67). Borghesi does not explicitly disclose selecting a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and displaying the second insurance claim processing step on the display device.

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However, these features are known in the art, as evidenced by Abbruzzese. In particular, Abbruzzese suggests selecting a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and displaying the second insurance claim processing step on the display device (Col.17, lines 22-67 to Col.18, line 67; Col.19, lines 1-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Abbruzzese within the system of Borghesi with the motivation of providing a claim office supervisors and other staff members with the ability to maintain an accurate record to all activities undertaken in the processing of a claim and the further ability to quickly and easily access the complete claim file (See Abbruzzese, Col.3, lines 12-17).

(B) As per claim 61, Borghesi discloses the method wherein displaying the second insurance claim processing step comprises displaying a report on the display device, wherein the report comprises a value of the insurance claim, and wherein the report is determined based on information input in the first insurance claim processing step and on any insurance claim processing steps in between the first insurance claim processing step and the second insurance claim processing step (Col.5, lines 19-67 to Col.6, line 51).

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(C) As per claim 62, Borghesi discloses the method further comprising: redisplaying the first insurance claim processing step after displaying the second insurance claim processing step (The Examiner interprets refresh the display as a form of redisplay Col.5, lines 51-67 to Col.6, lines 15-45).

(D) As per claim 63, Borghesi discloses the method further comprising: redisplaying the first insurance claim processing step after displaying the second insurance claim processing step; and receiving input regarding the first insurance claim processing step after redisplaying the first insurance claim processing step (Col.5, lines 51-67 to Col.6, line 45).

(E) As per claim 64, Borghesi discloses the method further comprising: redisplaying the first insurance claim processing step after displaying the second insurance claim processing step (Col.5, lines 51-67 to Col.6, line 45); receiving input regarding the first insurance claim processing step after redisplaying the first insurance claim processing step (Col.5, lines 51-67 to Col.6, line 45); and determining the table of contents again based at least in part on input received regarding the first insurance claim processing step and input received regarding the second insurance claim processing step (Col.7, lines 22-67 to Col.8, line 49).

(F) As per claim 65, Borghesi discloses the method wherein the insurance claim comprises a bodily injury claim, and wherein processing the insurance claim to estimate

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the value of the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value (Col.5, lines 1-36).

(G) As per claim 66, Borghesi discloses the method further comprising: receiving input regarding the second insurance claim processing step (Col.7, lines 22-67 to Col.8, line 49); and determining the table of contents again based at least in part on input received regarding the second insurance claim processing step (Col.7, lines 22-67 to Col.8, line 49).

(H) As per claim 67, Abbruzzese discloses the method wherein the table of contents comprises an ordered list of insurance claim processing steps (Col.19, lines 18-67).

(I) As per claim 68, Borghesi discloses the method wherein insurance claim processing steps comprise steps for entry of information relevant to the estimate of the value of the insurance claim (Col.5, lines 1-50).

(J) As per claim 69, Abbruzzese discloses the method wherein the information relevant to the estimate of the value of the insurance claim comprises bodily injury treatment information (Col.27, lines 1-67).

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(K) As per claim 70, Abbruzzese discloses the method wherein the information relevant to the estimate of the value of the insurance claim comprises bodily injury damages information (Col.30, lines 17-67).

(L) As per claim 71, Abbruzzese discloses the method wherein the table of contents further comprises pointers to display screens associated with the insurance claim processing steps (Col.30, lines 17-67 to Col.31, line 67).

(M) As per claim 72, Borghesi discloses the method further comprising: storing information input at one or more insurance claim processing steps (Col.6, lines 1-44).

(N) As per claim 73, Abbruzzese discloses the method wherein insurance claim processing steps are associated with display in table of contents properties (Col.39, lines 25-67 to Col.40, line 47), and wherein determining the table of contents comprises determining insurance claim processing steps associated with display in table of contents properties which indicate that the insurance claim processing steps should be included in the table of contents (Col.39, lines 25-67 to Col.40, line 47).

(O) As per claim 74, Abbruzzese discloses the method wherein insurance claim processing steps are associated with display in table of contents properties, wherein determining the table of contents comprises determining insurance claim processing steps associated with display in table of contents properties which indicate that the

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insurance claim processing steps should be included in the table of contents, and wherein at least on display in table of contents properties comprises a condition which specifies when an associated insurance claim processing step should be included in the table of contents (Col.39, lines 25-67 to Col.40, line 47).

(P) As per claim 75, Borghesi discloses a method of processing an insurance claim using an insurance claim processing system (Col.20, lines 34-50), comprising: receiving a request to estimate an insurance claim (Col.5, lines 1-67), wherein the request comprises a claim identifier associated with the insurance claim (Col.6, lines 33-67); selecting at least one step associated with the insurance claim (Col.5, lines 1-36); if the selected step is not the end step then: providing a display on a display device coupled to a computer system associated with the selected step (Col.11, lines 19-67 to Col.12, line 35); receiving input associated with the selected step (Col.5, lines 6-67); storing the input received (Col.5, lines 51-67 to Col.Col.6, line 51); and if the selected step is the end step then: providing a display on the display device comprising an estimated value of the insurance claim (Col.5, lines 27-67 to Col.6, line 32). Borghesi does not explicitly disclose determining a display of table of contents associated with the claim identifier, wherein the table of contents display represents one or more steps for processing the insurance claim, and wherein at least one step comprises an end step.

However, this feature is known in the art, as evidenced by Abbruzzese .In particular, Abbruzzese suggests a display of table of contents to the client system associated with said claim identifier, wherein the table of contents display represents

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one or more steps associated with said insurance claim, wherein one of the one or more steps comprises an end step (See Abbruzzese Col.17, lines 22-67 to Col.18, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Abbruzzese within the system of Borghesi with the motivation of providing a claim office supervisors and other staff members with the ability to maintain an accurate record of all activities undertaken in the processing of a claim and the further ability to quickly and easily access the complete claim file (See Abbruzzese Col.3, lines 12-17).

(Q) As per claim 76, Borghesi discloses the method wherein the one or more steps for processing the insurance claim are dynamically modifiable in response to received input (Col.5, lines 27-67).

(R) As per claim 77, Borghesi discloses the method further comprising adding or deleting one or more steps from the table of contents display in response to received input (Col.8, lines 15-64).

(S) Claim 78 differs from claims 60 and 75 by reciting a method for dynamically creating a table of contents display screen on a display device coupled to a computer system.

As per this limitation, it is noted that Borghesi discloses wherein the table of contents display screen is associated with a specified insurance claim (Col.8, lines 3-67), determining whether a previous display screen pointer is associated with a display

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screen of a set of one or more display screens associated with a specified insurance claim (Col.7, lines 40-53); if a previous display screen pointer is not associated with the display screen, adding the display screen to said table of contents display screen (Col.7, lines 40-53); if a previous display screen pointer is associated with the display screen, determining whether a source of data property associated with the display screen indicates that data associated with the display screen is input received from a user (Col.4, lines (Col.7, lines 40-67); if the source of data property associated with the display screen indicates that data associated with the display screen is input received from a user (Col.4, lines 40-67) and Abbruzzese discloses adding the display screen to the table of contents display screen; and storing said table of contents display screen.

Thus, it is readily apparent that these prior art systems utilize a table of contents display screen on a display device coupled to a computer system to perform their specified function.

The remainder of claim 78 is rejected for the same reason given above for claims 60 and 75, and incorporated herein.

(T) As per claim 79, Borghesi discloses a system for processing an insurance claim to estimate a value of the insurance claim (Col.1, lines 24-55), the system comprising: a CPU (Col.7, lines 10-28); a display device coupled to the CPU (Col.6, lines 6-14); a memory coupled to the CPU, wherein the memory stores program instructions which are executable by the CPU (Col.6, lines 6-14) to:

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display a first insurance claim processing step (Col.6, lines 1-45); receive input regarding the first insurance claim processing step (Col.5, lines 16-67); determine a table of contents based at least in part on input received regarding the first insurance claim processing step; display a table of contents, wherein the table of contents comprises a list of the steps associated with the processing of the insurance claim, and wherein the list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps (Col.8, lines 30-67). Borghesi does not explicitly disclose select a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and display the second insurance claim processing step.

However, these features are known in the art, as evidenced by Abbruzzese. In particular, Abbruzzese suggests select a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and display the second insurance claim processing step (See Abbruzzese, Col.16, lines 23-67 to Col.17, lines 1-67; Col.18, lines 1-67).

(U) Claims 80-93 and 95-108 recite the underlying process steps of the elements of claims 61-74 respectively. As the various elements of claims 61-74 have been shown to be either disclosed by or obvious in view of the collective teachings of Borghesi and Abbruzzese, it is readily apparent that the apparatus disclosed by the applied prior art

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performs the recited underlying functions. As such, the limitations recited in claims 80-93 and 95-108 are rejected for the same reasons given above for method claims 61-74, and incorporated herein.

(V) Claim 94 differs from claims 60, 75, 78-79 by reciting a carrier medium comprising program instructions for processing an insurance claim to estimate a value of the insurance claim, wherein the program instructions are computer-executable to implement.

As per this limitation, it is noted that Borghesi discloses displaying a first insurance claim processing step (Col.3, lines 13-23); receiving input regarding the first insurance claim processing step (Col.2, lines 60-67 to Col.3, line 30);

determining a table of contents based at least in part on input received regarding the first insurance claim processing step (Col.7, lines 24-67 to Col.8, line 49); displaying a table of contents, wherein the table of contents comprises a list of the steps associated with the processing of the insurance claim, and wherein the list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps (Col.8, lines 30-67; Col.10, lines 29-67 to Col.11, line 18) and Abbruzzese discloses selecting a second insurance claim processing step, wherein the second insurance claim processing step comprises at least one of the additional insurance claim processing steps from the table of contents; and displaying the second insurance claim processing step.

Thus, it is readily apparent that these prior art systems utilize program instructions to perform their specified function.

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The remainder of claim 94 is rejected for the same reason given above for claims 60, 75, 78-79, and incorporated herein.

(W) As per claim 109, Borghesi discloses a method for processing an insurance claim to estimate a value of the insurance claim (Col.1, lines 24-55), the method comprising: receiving a first input associated with an insurance claim processing step displayed on a display device (Col.5, lines 51-67 to Col.6, line 67); determining a list of insurance claim processing steps to present in a table of contents based on at least part of the first input received (Col.7, lines 17-67 to Col.8, line 67); displaying a list of insurance claim processing steps to present in a table of contents based on at least part of the first input received; displaying a table of contents on the display device with the determined list of insurance claim processing steps (Col.8, lines 3-67 to Col.9, line 67; Col.10, lines 29-67); selecting at least one of the insurance claim processing steps displayed in the table of contents (Col.8, lines 3-67 to Col.9, line 67; Col.10, lines 29-67); displaying the selected insurance claim processing step on the display device (Col.10, lines 29-67 to Col.11, line 19).

Borghesi does not explicitly disclose receiving a second input associated with the selected insurance claim processing step; and determining a new list of insurance claim processing steps to present in the table of contents based on at least part of the first input received; and displaying the table of contents with the new list of insurance claim processing steps.

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However, these features are known in the art, as evidenced by Abbruzzese. In particular, Abbruzzese suggests receiving a second input associated with the selected insurance claim processing step; and determining a new list of insurance claim processing steps to present in the table of contents based on at least part of the first input received; and displaying the table of contents with the new list of insurance claim processing steps (Col.17, lines 22-67 to Col.18, line 67; Col.19, lines 1-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Abbruzzese within the system of Borghesi with the motivation of providing a claim office supervisors and other staff members with the ability to maintain an accurate record to all activities undertaken in the processing of a claim and the further ability to quickly and easily access the complete claim file (See Abbruzzese, Col.3, lines 12-17).

(X) As per claim 110, Abbruzzese discloses the method wherein determining a list of insurance claim processing steps includes determining an order that the insurance claim processing steps should be completed in based on at least part of the first input received (Col.19, lines 1-67; Col.29, lines 1-67 to Col.30, line 67).

(Y) As per claim 111, Abbruzzese discloses the method wherein determining a list of insurance claim processing steps includes adding or removing at least one insurance claim processing step from a predetermined list of insurance claim processing steps on

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at least part of the first input received (Col.27, lines 47-67 to Col.28, line 67; Col.30, lines 21-67 to Col.31, line 67).

Z) As per claim 112, Abbruzzese discloses the method wherein determining a list of insurance claim processing steps includes adding or removing at least one insurance claim processing step from a predetermined list of insurance claim processing steps on at least one business rule used to determine what insurance claim processing steps require further data entry (Col.33, lines 10-67 to Col.34, line 67).

(AA) As per claim 113, Borghesi discloses the method wherein determining a list of insurance claim processing steps includes adding or removing at least one insurance claim processing step from a predetermined list of insurance claim processing steps on at least one business rule used to determine what insurance claim processing steps require further data entry (Col.10, lines 29-67 to Col.11, line 67).

(BB) As per claim 114, Borghesi discloses the method wherein displaying a table of contents includes displaying at least one screen object next to at least one insurance claim processing step in the displayed table of contents, wherein the appearance of the at least one screen object is selected based on the status of the at least one insurance claim processing step (Col.10, lines 29-67 to Col.11, line 67).

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(CC) As per claim 115, Abbuzzese discloses the method wherein the at least one screen object includes an arrow pointing to an insurance claim processing step that should be completed after the insurance claim processing step associated with the at least one screen object (Col.33, lines 10-67 to Col.34, line 67).

Response to Arguments

7. Applicant's arguments filed 10/24/03/06/03 with respect to claims 60-108 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/24/03.

(A) At pages 15-33 of the 10/24/03 response, Applicant's argues that the features in the 10/24/03 amendment are not taught by or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 10/24/03 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Borghesi and/or Abbruzzese based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 11), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches a system for web-based payroll and benefits administration (6,401,079), insurance claims estimate, text, and graphics network and method (5,504,674).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
January 7, 2004


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600